

Appln. No. 09/701,132

**REMARKS**

Continued prosecution and consideration of the claimed subject matter in the above-identified patent application is respectfully requested.

Claims 1 through 46 have been cancelled to speed prosecution. Claims 47 through 58 have been added, are in the case and are before the Examiner.

A. The Amendments

The description of Figure 1 has been amended pursuant to the Examiner's helpful suggestions by adding the "SEQ ID NO:" and designation "1" to that description. A new, more descriptive title has been added in accord with another of the Examiner's helpful suggestions, and an Abstract substantially identical to that of the published PCT application has been added as a separate sheet.

Prior claims 1-46 have been cancelled to speed prosecution and have been replaced by new claims 47-58. These new claims have support in the prior claims and also within the specification. It is thus believed that no new matter has been added.

B. Rejections and Objections

It is believed that the present amendments make moot or otherwise overcome the stated objections and rejections under 35 USC §§ 101 and 112, second paragraph.

An appropriate new Oath has been forwarded to the inventors for execution and will be filed upon its receipt.

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C. Rejections Under 35 USC § 102(b)

Prior claims 1-14 and 20-22 were said to be anticipated by the disclosures of Hashimoto et al. (1993) *E. J. Biochem.* **218**:585-595 [hereinafter Hashimoto]. It is believed that the present claims overcome or otherwise make moot this basis for rejection at least because (1) as to claim 47 and its dependent claims, there is no teaching or suggestion in Hashimoto of the relatively short nucleic acid claimed, and (2) as to claim 50 and its dependent claims, the Hashimoto construct  $\lambda$ NF-32 that is relied upon in the Action extends further to the coding side (+) of the initiation codon than any substantially purified sequence of the claims.

D. Rejections Under 35 USC § 103(a)

1) Claims 16-18 and 37-39

Prior claims 16-18 and 37-39 were rejected as allegedly obvious from the Hashimoto disclosures in relation to cells and vectors containing the  $\lambda$ NF-32 construct as discussed above. The Action admits that the teaching lacks specifics about the cloning and expression, but asserts that the prior claims were prime facie obvious. This basis for rejection cannot be agreed with and is respectfully traversed to the extent it is still applicable in view of the present amendments.

It is submitted that the relied-on teaching misses the point for the present claims for the same reason Hashimoto did not anticipate the present claims. It is submitted that the Hashimoto teaching is no more relevant to the present claims than is a teaching of the entire gene and 5' region in that the present inventors have found and identified the pea under the mattresses piled up by previous workers such as Hashimoto who

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felt a bump and built constructs that were too big and extended in the wrong direction; i.e., toward the 3' end of the DNA, but did not know what the bump was that interrupted their sleep. It is thus submitted that this rejection should be withdrawn.

## 2. Claim 46

Claim 46 was rejected as allegedly obvious over the teachings of Hashimoto as above further in view of the Ahern paper, [Ahern (1995) *The Scientist* **9(15):20**]. Ahern was cited because of its teachings of the benefits of a kit. This rejection is respectfully traversed in view of the previous discussion as applied to the present claim in that if one does not know what nucleic acid to use, knowledge that kits are useful is of little help in preparing a kit of the present claims. As already pointed out, Hashimoto does not lead one to the appropriate sequence and thus cannot suggest a claimed kit when combined with any other teaching. This rejection should be withdrawn.

## E. Summary

Each basis for rejection has been dealt with and has been overcome or otherwise made moot.


It is therefore believed that this application is in condition for allowance of all of the claims. An early notice to that effect is earnestly solicited.

A Petition for a three Month Extension of Time to Respond is enclosed along with a check for its fee. No further fee or petition is believed to be necessary. However, should any further fee be needed, please charge our Deposit Account No. 23-0920, and deem this paper to be the required petition.

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The Examiner is requested to phone the undersigned should any questions arise that can be dealt with over the phone to expedite this prosecution.

Respectfully submitted,

By   
Edward P. Gamson Reg. No. 29,381

WELSH & KATZ, LTD.  
120 South Riverside Plaza, 22nd Floor  
Chicago, Illinois 60606  
Phone (312) 655-1500  
Fax No. (312) 655-1501

Enclosure

Petition and fee

CERTIFICATE OF MAILING

I hereby certify that this Reply, and the Petition and fee (Check No. 089308) are being deposited with the United States Postal Service as First Class mail, postage prepaid in an envelope addressed to Commissioner for Patents, Mail Stop Amendments, P.O. Box 1450, Alexandria, VA 22313-1450, on September 10, 2004.

